

Appl. No.: 09/875,237
Group Art Unit: 1714
Applicants' Reply to the Office Action Dated May 27, 2004

REMARKS

Claims 1-30 are currently pending in the present application.

In the Office Action, the Examiner maintains the rejection of claims 1-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,399,741 of Fry, *et al.* (hereinafter referred to as "Fry" or "the Fry reference"), and makes this rejection FINAL.

The Examiner continues to contend that while the conflicting claims are not identical, they are not patentably distinct because "the ordinary practitioner in this art would be able to determine that a color stabilizing effective amount of the number of reactive amino functionalities is between 20% and 60%." (See, the Office Action, p.3). On this basis, the Examiner again argues that the instant claims would have been obvious over the claims of the Fry reference.

Applicants strenuously traverse the Examiner's rejection and the arguments and contentions set forth in support thereof because the Fry reference fails to contain disclosure, either explicit or implicit, which satisfies the criteria necessary to establish *prima facie* obviousness, or in this case, sustain a rejection based upon obviousness-type double patenting.

First, the Fry reference specifically teaches that "a 'color stabilizing-effective amount', means an amount which is at least about 60-65% of the total number of reactive amino functionalities present in a given polyalkyleneimine backbone." (See, Fry, col. 4, lines 39-44). However, the Examiner summarily argues that one of ordinary skill in the art would somehow come to the conclusion that a color stabilizing-effective amount of the number of reactive amino functionalities is between 20% and 60%, *in direct contradiction to the express teachings of the Fry reference.*

Applicants respectfully submit that it is clear error for the Examiner to conclude that Fry teaches or suggests that from 20% and 60% of the number of reactive amino functionalities is a color stabilizing-effective amount, when the reference specifically teaches at least about 60-65%, preferably at least about 75%, and most preferably up to at least about 94%. (See, Fry, col. 4, lines 39-60).

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Moreover, this clear distinction between a color stabilizing-effective amount as taught in the Fry reference (*i.e.*, at least about 60-65%), and the instantly claimed "from 20% to 60%" applies equally in traversing the Examiner's rejection as to the instant process claims, polymer claims and fiber lubricant claims as well.

Second, while the Fry reference teaches the use of virtually any carboxylic acid as a substituent, and thus contains some overlap, the reference specifically notes a preference for acids having from 2 to 18 carbon atoms, and even more preferably, from 2 to 9 carbon atoms. Accordingly, the Fry reference generally teaches away from Applicants' claimed invention in which the substituent acids have from about 14 to about 20 carbon atoms.

One of ordinary skill in the art, upon reading the Fry reference, would not be motivated to modify the teachings of that reference to select only carboxylic acids, where the reference teaches the use of acids and amine-protecting substituents, nor would one of ordinary skill in the art be motivated to specifically select C₁₄-C₂₀ acids when preference is clearly given to shorter chain acids.

Accordingly, Applicants submit that the claimed invention is patentably distinct from the claims of the Fry reference and that no improper timewise extension of the right to exclude would result from the patenting of the instant claims.

In view of the comments set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

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Respectfully submitted,

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